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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,907	02/09/2004	Hubertus Edward Paprotna	2004P00441US	8785

7590 07/25/2005

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

PATEL, VISHAL A

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,907

Applicant(s)

PAPROTNA ET AL.

Examiner

Vishal Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 9-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, claim 1 is generic. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/12/05.

Applicant has indicated that claim 8 reads on the elected species is not correct as indicated in the specification claim 8 is directed to a different species (for example species of figure 9, hence claim 8 is also withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, line 1, "at least one tooth", is this the same one tooth as claimed in claim 1? For examination purpose at least one tooth mentioned in claim 5, line 1 is the same as one claimed in claim 2.

Claim 6, "an intersection", should be changed to "the intersection".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards (US. 4,976,444).

Richards discloses a seal usable between two thermally movable components (intended use). The seal comprising a body having a longitudinal axis (axis parallel to surface 76), the body has a cross-section orthogonal to the longitudinal axis that has a first side (first side having surface 82), a second side (second side having surface 80) generally opposite the first side, a first end (end having teeth 86, 88, 90 and 72) and a second end (second end having surface 76) generally opposite the first end. The first end is formed from a compliant material (compliant material being the teeth) configured to absorb thermal expansion of the two thermally movable components.

Regarding claims 2-4: The compliant material includes at least one tooth (86) extending from the first end (teeth 86, 88, 90 and 92). The at least one tooth is at an angle of between about 30-60 degrees relative an outer surface of the first end (the surface would be the surface formed by the tip of the teeth or a groove 94 having the bottom surface).

Regarding claims 5 and 7: The seal having at least one tooth (86) extends from a region proximate to an intersection between the first end and the first side and at least one tooth (92) extends from a region proximate to an intersection between the first end and the second side. The at least one tooth extending from the region proximate to the intersection between the first end and the first side comprises three teeth (86, 88 and 96).

6. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Milazar (US. 5,975,844).

Milazar discloses a seal usable between two thermally movable components (intended use). The seal comprising a body having a longitudinal axis (axis parallel to surface 9b), the body has a cross-section orthogonal to the longitudinal axis that has a first side (first side 6a), a second side (second side 6b) generally opposite the first side, a first end (end having teeth 9a) and a second end (second end 9b) generally opposite the first end. The first end is formed from a compliant material (compliant material being the teeth) configured to absorb thermal expansion of the two thermally movable components.

Regarding claims 2-3: The compliant material includes at least one tooth (9a) extending from the first end (teeth 9a extends from first end). The at least one tooth is at an angle of between about 30-60 degrees relative an outer surface (surface parallel to 4) of the first end.

Regarding claims 5-7: The seal having at least one tooth (9a near 6a) extends from a region proximate to an intersection between the first end and the first side and at least one tooth (9a near 6b) extends from a region proximate to an intersection between the first end and the second side. The at least one tooth extending from the region proximate to the intersection between the first end and the first side comprises three teeth (three 9a near 6a) and the at least one tooth extending from the region proximate to the intersection between the first end and the second side comprises three teeth (three teeth 9a near 6b).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cress teaches tooth on a seal, Boethien et al, Paprotna teaches a seal with tooth at an end of the seal, Tong, Fischer, Starkweather, Wong et al, Beckershoff, Mori et al and Smed.

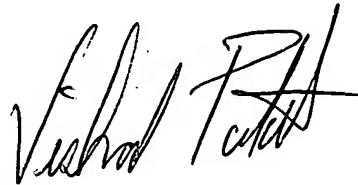
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP
July 14, 2005

A handwritten signature in black ink, appearing to read 'Vishal Patel', is written over a horizontal line.

Vishal Patel
Patent Examiner
Tech. Center 3600